



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: landegren=1a

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| In re Application of: |) | Art Unit: 1637, |
| |) | |
| Ulf LANDEGREN et al |) | Examiner: S. Chunduru |
| |) | |
| Appln. No.: 09/785,657 |) | Washington, D.C. |
| |) | |
| Date Filed: February 20, 2001 |) | Confirmation No. 5356 |
| |) | |
| For: METHODS AND KITS FOR |) | January 12, 2004 |
| PROXIMITY PROBING |) | <u>Monday</u> |

**REPLY: REQUEST FOR RECONSIDERATION AND SUBMISSION OF
RULE 132 DECLARATION**

Mail Stop NON-FEE REPLY
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The present applicants are in receipt of Paper No. 18, the Office Action mailed October 10, 2003. The claims in the application remain as claims 2-7, 13-15 and 17-25. These claims define novel and unobvious subject matter and should be allowed. Accordingly, the applicants respectfully request favorable reconsideration and allowance.

Acknowledgement by the PTO of applicants' claim for domestic priority is noted.

Claims 2-5, 7, 19-20 and 22-25 have been rejected under §102(e) as anticipated by Landegren USP 6,558,928

(Landegren '928). Claim 6 and 13-15 have been rejected as obvious under §103 from Landegren '928 in view of Landegren WO97/00446 (Landegren '446). Claims 17, 18 and 21 have been rejected as obvious under §103 from Landegren '928 in view of Landegren et al USP 4,988,617 (Landegren '617). These rejections, all of which rely on Landegren '928 being "prior art", are respectfully traversed.

Respectfully, Landegren '928 is not prior art, and therefore all the rejections must fall.

First, with reference to flow charts provided by the PTO for the determination of 35 USC 102(e) dates, especially "Chart I: for U.S. patent or U.S. patent application publication...", the first step is to determine if the reference is a U.S. patent or a U.S. application publication of an international application. In this case, the answer is "yes". The next question is, "Was the IA filed on or after November 29, 2000? - Look at the international filing date." In this case the answer is "no" because the international filing date was prior to November 29, 2000, i.e. on March 25, 1999.

When the answer is "no", the chart says: " For a **patent**: §102(e) date is the §371 (c) (1), (2) and (4) date *form paragraph 7.1201*" That date for Landegren '928 is March 16, 2001, **after** the filing date of the present application on February 20, 2001.

Accordingly, Landegren '928 is not prior art against the present application because its effective date is after applicants' filing date; and the rejections, insofar as they reply and depend on Landegren '928, must be withdrawn.

Nevertheless, applicants further respond as if the rejections were based on the equivalent Landegren WO99/49079 (Landegren '079). In this regard, and assuming that the aforementioned rejections were each to be based on Landegren '079, applicants submit herewith a Declaration under 37 CFR 1.132 executed by both of the present applicants, which of course includes the inventor of the subject matter of Landegren '928 and Landegren '079.

This Declaration confirms that the subject matter claimed in the present application which is disclosed in Landegren '928 and Landegren '079 is the invention of the present applicants, i.e. in some cases the joint invention of the present applicants and in some cases the sole invention of one of the present applicants. In this regard, attention is respectfully invited to MPEP 715.01(c) under the heading "Derivation", and the case law cited therein. Further in this regard, please see MPEP 716.10, and the case law cited therein, particularly *In re Katz*, 215 USPQ 14, 18 (CCPA 1982). Further in this regard, please also see MPEP 2136.04 and 2136.05.

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As there is no statutory bar under 35 USC 102(b), the attached Declaration under 37 CFR 1.132 establishes that the relevant disclosure in Landegren '928 and Landegren '079 is the work of the present applicants. To the extent that Landegren '928 and Landegren '079 were *prima facie* "prior art" they are no longer prior art in view of the attached Declaration.

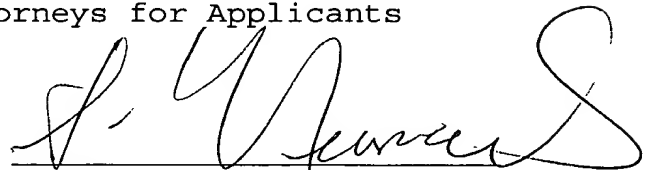
Withdrawal of all of the rejections is in order and is respectfully requested.

All issues having been addressed and resolved above and in view of the attached Declaration, applicants respectfully request favorable consideration and early formal allowance.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicants

By


Sheridan Neimark
Registration No. 20,520

SN:jaa
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
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